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UNITED STATES DISTRICT COURT

15 **CENTRAL DISTRICT OF CALIFORNIA-WESTERN DIVISION**

16 SAJAHTERA, INC., a Delaware
17 Corporation, dba THE BEVERLY
18 HILLS HOTEL

19 Plaintiff,

20 v.

21 KITROSS APPAREL LOS ANGELES,
22 LLC, a California limited liability
23 company; and DOES 1 through 50,

24 Defendants.

25 Case No: 2:23-cv-08005

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1 Plaintiff and counter defendant Sajahtera, Inc., dba The Beverly Hills Hotel (“the
2 Hotel”) brings the following motion to dismiss the counterclaim of defendant and
3 counterclaimant Kitross Apparel Los Angeles, LLC (“Kitross”).

4 **I. INTRODUCTION**

5 Relying on the same theories plainly disposed of by this court in denying
6 Kitross’s motion to dismiss the Hotel’s complaint, Kitross asserts its Counterclaim
7 consisting of four claims for relief: Declaratory judgment of noninfringement of
8 registered trademarks state and unfair competition in violation of California Business
9 and Professions Code section 17200, declaratory judgment of non-dilution,
10 cancelation of trademark registration, and tortious interference of prospective
11 economic relations.

12 All causes of action should be dismissed under Federal Rule of Civil Procedure
13 12(b)(6). The Hotel’s complaint herein states three causes of action: Trademark
14 Infringement, Trademark Dilution, and Unfair Competition Under California
15 Business and Professions Code section 17200. The first and second causes of action
16 are mere “mirror image” claims for declaratory judgment of complaints three causes
17 of action. The third cause of action of the counterclaim should be dismissed as
18 Kitross has failed to allege facts sufficient to support that the Hotel’s Mark has
19 become generic. The fourth cause of action of the counterclaim must likewise be
20 dismissed as Kitross has failed to allege any independent wrongful conduct as
21 required for its tortious interference claim. Finally, portions of the Counterclaim are
22 impertinent to the claims presented in either the complaint or counterclaim and
23 should be stricken under Rule 12(f).

24 **II. LEGAL AUTHORITY**

25 Rule 12(b)(6) mandates dismissal when a plaintiff has failed to “state a claim
26 upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6).

27 Federal Rule of Civil Procedure 12(f) permits a court to “strike from a pleading
28 an insufficient defense or any redundant, immaterial, impertinent, or scandalous

1 matter.” A Rule 12(f) motion to strike serves “to avoid the expenditure of time and
2 money that must arise from litigating spurious issues by dispensing with those issues
3 prior to trial.” *SidneyVinstein v. A.H. Robins Co.*, 697 F.2d 880, 885 (9th Cir. 1983);
4 see also . A court may also strike matter that is immaterial i.e., “that which has no
5 essential or important relationship to the claim for relief or the defenses being plead,”
6 or matter that is impertinent, i.e., that which does not pertain, and is not necessary, to
7 the issues in question. (*Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993),
8 rev'd on other grounds, 510 U.S. 517 (1994).)

9 **III. ARGUMENT**

10 **A. The First and Second Causes of Action Should be Dismissed as They**
11 **Are Mere Mirror Images of Causes of Action in the Hotel’s**
12 **Complaint**

13 The Declaratory Judgment Act authorizes courts to “declare the rights and
14 other legal relations of any interested party seeking such declaration.” 28 U.S.C. §
15 2201. The Act gives courts the ability to issue declaratory relief but does not require
16 them to do so. See *Chesebrough-Pond's, Inc. v. Faberge, Inc.*, 666 F.2d 393, 396 (9th
17 Cir. 1982) (“Declaratory relief is available at the discretion of the district court.”).
18 Rather, the Supreme Court has held that a declaratory judgment claim is appropriate
19 only when it serves a useful purpose. See *Wilton v. Seven Falls Co.*, 515 U.S. 277,
20 288 (1995) (“If a district court, in the sound exercise of its judgment, determines after
21 a complaint is filed that a declaratory judgment will serve no useful purpose, it cannot
22 be incumbent upon that court to proceed to the merits before staying or dismissing
23 the action.”)

24 Declaratory judgment counterclaims are analyzed under the “mirror image”
25 rule. Under the rule, a defendant is not be permitted to assert a Counterclaim that
26 “merely restate[s] issues already before the court as part of a plaintiff’s affirmative
27 case.” *Atlantic Recording Corp. v. Serrano*, no. 07-1824, 2007 WL 4612921, *4
28 (S.D. Cal. Dec. 28, 2007) (citing *Avery Dennison Corp. v. Acco Brands, Inc.*, no. 99-

1 1877DT, 2000 WL 986995 (C.D. Cal. Feb. 22, 2000)). In those cases, dismissal is
2 appropriate where “both the plaintiff’s claim and a defendant’s counterclaim seeking
3 declaratory relief raise identical factual and legal issues,” thereby making the
4 counterclaim redundant. Avery Dennison Corp., no. 99-1877DT, 2000 WL 986995,
5 at *4 (citing *Aldens, Inc. v. Packel*, 524 F.2d 38, 51-52 (3d Cir. 1975)).

6 Where a defendant in a trademark infringement suit asserts a Counterclaim
7 seeking a declaratory judgment of non-infringement and non-dilution, a motion to
8 dismiss is proper. See Avery Dennison Corp., no. 99-1877DT, 2000 WL 986995, at
9 *4. Such claims are superfluous in light of the plaintiff’s underlying infringement
10 claim. Id.; see also *Interscope Records v. Duty*, no. 05-3744, 2006 WL 988086, at *
11 12 (D. Ariz. Apr. 14, 2006) (dismissing analogous Counterclaim seeking declaration
12 of copyright non-infringement, because the Counterclaim was “redundant and
13 unnecessary.”) Accordingly, these counterclaims are properly dismissed without
14 prejudice and all of the pertinent issues are resolved by the Court’s adjudication of
15 the plaintiff’s underlying infringement claim. Id.; see also *Capitol Records, Inc. v.*
16 *Weed*, no. 06-01124, 2008 WL 1820667 (D. Ariz. Apr. 22, 2008) (refusing
17 defendant’s motion for leave to add non-infringement Counterclaim because “some
18 courts have ruled that a declaratory judgment for non-infringement is subject to
19 dismissal when it is redundant of other claims that will already be addressed in the
20 case”).

21 A counterclaim is subject to dismissal if it serves no purpose other than to
22 restate the defendant’s affirmative defenses. See *Englewood Lending Inc. v. G & G*
23 *Coachella Investments, LLC*, no. 09-223, 2009 WL 2566870, *4 (C.D. Cal. Aug. 17,
24 2009); *Rayman v. Peoples Sav. Corp.*, 735 F. Supp. 842, 852-53 (N.D. Ill. 1990)
25 (recognizing that the court should disregard a Counterclaim that “simply duplicates
26 arguments made by way of affirmative defense”). The purpose of the Declaratory
27 Judgment Act is to relieve potential defendants from the “threat of impending
28 litigation” but once a defendant is “already obliged to defend against” a suit,

1 declaratory judgment on counterclaim no longer serves the purpose of the Act.
2 Englewood Lending Inc., no. 09-223, 2009 WL 2566870, at *4.

3 Here, the first claim for relief in the Hotel's complaint is for infringement of
4 the Hotel's protected mark. The second claim for relief is for dilution of the Hotel's
5 protected mark. The third claim for relief is violation of California's unfair
6 competition law under California Business and Professions Code section 17200, et
7 seq. by virtue of Kitross's infringement and dilution of the Hotel's protected mark.

8 The first cause of action of Kitross's Counterclaim seeks a declaratory
9 judgment that Kitross is not infringing on the Hotel's protected mark, and that it is
10 not in violation of California Business and Professions Code section 17200 by virtue
11 of the alleged infringement and dilution. The second cause of action in Kitross's
12 counterclaim seeks a declaratory judgment that Kitross does not dilute the Hotel's
13 protected mark. In other words, the first and second causes of action in the
14 counterclaim are precise mirror images of the first three claims for relief in the
15 Hotel's complaint and, for that reason, should be dismissed. These counterclaims
16 involve the same factual and legal issues and basis as those included in the Hotel's
17 Complaint.

18 **B. The Third Cause of Action Fails to Allege Sufficient Facts For A**
19 **Claim That the Hotel's Mark Has Become Generic**

20 Genericide occurs when the public appropriates a trademark and uses it as a
21 generic name for particular types of goods or services irrespective of its source. For
22 example, ASPIRIN, CELLOPHANE, and ESCALATOR were once protectable as
23 arbitrary or fanciful marks because they were primarily understood as identifying the
24 source of certain goods. But the public appropriated those marks and now primarily
25 understands aspirin, cellophane, and escalator as generic names for those same
26 goods. *See Bayer Co. v. United Drug Co.*, 272 F. 505, 510 (S.D.N.Y. 1921); *DuPont*
27 *Cellophane Co. v. Waxed Prods. Co.*, 85 F.2d 75, 82 (2d Cir. 1936); *Freecycle*
28 *Network, Inc.*, 505 F.3d at 905.

1 The question in any case alleging genericide is whether a trademark has taken
2 the “fateful step” along the path to genericness. *Ty Inc. v. Softbelly's Inc.*, 353 F.3d
3 528, 531 (7th Cir. 2003). The mere fact that the public sometimes uses a trademark
4 as the name for a unique product does not immediately render the mark generic. *See*
5 15 U.S.C. § 1064(3). Instead, a trademark only becomes generic when the “primary
6 significance of the registered mark to the relevant public” is as the name for a
7 particular type of good or service irrespective of its source. *Id.* The ninth circuit has
8 often described this as a “who-are-you/what-are-you” test. *See Yellow Cab Co. of*
9 *Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 929 (9th Cir. 2005)
10 (quoting *Filipino Yellow Pages, Inc.*, 198 F.3d at 1147). If the relevant public
11 primarily understands a mark as describing “who” a particular good or service is, or
12 where it comes from, then the mark is still valid. But if the relevant public primarily
13 understands a mark as describing “what” the particular good or service is, then the
14 mark has become generic. In sum, courts in the ninth circuit ask whether “the primary
15 significance of the term in the minds of the consuming public is [now] the product
16 [and not] the producer.” *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118, 59 S.Ct.
17 109, 83 L.Ed. 73 (1938).

18 However, in order to sustain a claim of genericide or genericness, the claim
19 must made be with regard to the particular good or service the mark is registered for.
20 *Elliott v. Google, Inc.*, 860 F.3d 1151, 1157 (9th Cir. 2017) (denying plaintiff's claim
21 for genericness of Google's mark because plaintiff failed to allege that Google had
22 become generic with regard to internet search engines); *see also Entrepreneur Media,*
23 *Inc. v. Dermer*, No. SACV181562JVSKESX, 2019 WL 4187466, at *7 (C.D. Cal.
24 July 22, 2019)(Holding that “[d]efendants have failed to plausibly allege how EMI's
25 ENTREPRENEUR mark is generic beyond the bare-bones, conclusory allegation
26 that the mark is generic.). This requirement is clear from the text of the Lanham Act,
27 which allows a party to apply for cancellation of a trademark when it “becomes the
generic name for the goods or services ... for which it is registered.” 15 U.S.C. §

1 1064(3) (emphasis added). The Lanham Act further provides that “[i]f the registered
2 mark becomes the generic name for less than all of the *goods or services* for which
3 it is registered, a petition to cancel the registration for only those *goods or services*
4 may be filed.” *Id.* (emphasis added). Finally, the Lanham Act specifies that the
5 relevant question under the primary significance test is “whether the registered mark
6 has become the generic name of [certain] *goods or services*.” *Id.* (emphasis added).
7 In this way, the Lanham Act plainly requires that a claim of genericide relate to a
8 particular type of good or service. *See Elliott v. Google, Inc.*, 860 F.3d at 1157.

9 Here, Kitross has failed to allege that the Hotel’s mark is generic for the good
10 or service the Hotel’s mark is registered for. Kitross merely asserts the conclusory
11 statement that the Hotel’s mark “ha[ve] become generic” but notably has not
12 indicated with regard to what good or service the mark is generic. *Entrepreneur*
13 *Media, Inc. v. Dermer*, 2019 WL 4187466, at *7. Ultimately, Kitross has failed to
14 allege sufficient facts to claim that the Hotel’s mark has become generic, and
15 therefore, Kitross’s claim for cancellation of the Hotel’s mark should be dismissed
16 under Rule 12(b)(6).

17 **C. The Fourth Cause of Action Fails to Allege a Wrongful Act As**
18 **Required for a Claim of Tortious Interference with Prospective**
19 **Economic Relations**

20 Kitross has failed to state facts showing “independently wrongful conduct” by
21 the Hotel, which is required for a claim of tortious interference with prospective
22 economic relations. In *Della Penna v. Toyota Motor Sales, U.S.A., Inc.*, 11 Cal.4th
23 376, 393 (1995) the California Supreme Court held that a plaintiff seeking to recover
24 damages for interference with prospective economic relations must plead and prove
25 as part of its case-in-chief that in the context of the third element the defendant’s
26 conduct was “wrongful by some legal measure other than the fact of interference
27 itself.” In satisfying the “independently wrongful conduct” requirement,
28 “Defendant’s liability may arise from improper motives or from the use of improper

means. They may be wrongful by reason of a statute or other regulation, or a recognized rule of common law or perhaps an established standard of a trade or profession." *Id.* at 385 (citations omitted). "[A]n act is independently wrongful if it is unlawful, that is, if it is proscribed by some constitutional, statutory, regulatory, common law, or other determinable legal standard." *Edwards v. Arthur Anderson*, 44 Cal.4th 937, 944 (2008).

Here, Kitross has failed to allege that the Hotel committed some independently wrong conduct outside of the allegations of tortious interference. The Hotel's mark is registered with USPTO and the Hotel is entitled to enforce its right to the mark. This enforcement includes the ability to send cease and desist letters and file suit against any entity infringing on its registered mark. Kitross has not and cannot allege otherwise that the Hotel committed some otherwise independently wrongful act and as a result, Kitross's Counterclaim should be dismissed under 12(b)(6).

D. Portions of Kitross's Counterclaim Should Be Stricken as Immaterial

Under FRCP 12(f), "[a] statement of unnecessary particulars in connection with and descriptive of a material matter may be stricken as 'immaterial.'" *Gilbert*, 56 F.R.D. at 120, n. 5; *Burke v. Mesta Mach. Co.*, 5 F.R.D. 134 (D.C.Pa.1946). "Immaterial" means that the matter has no bearing on the controversy before the court. If there is *any doubt* as to whether the allegations might be an issue in the action, courts will deny the motion. *Fantasy, Inc.*, 984 F.2d at 1527; *see also Gagan v. Gagnon*, No. 522CV00680SSSSPX, 2023 WL 3150081, at *1 (C.D. Cal. Mar. 2, 2023) (granting a plaintiff's motion to strike for immaterial language because facts about drug abuse were not required to prove defendant's counterclaims.). Superfluous historical allegations are properly subject to a motion to strike. *Id.*; *see, e.g., Healing v. Jones*, 174 F.Supp. 211, 220 (D.Ariz.1959).

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1 1. Geographically Descriptive

2 First, the references in the counterclaim to third parties' mere use of the name
3 “Beverly Hills” should be stricken as immaterial. *See* Defendant's Answer and
4 Counterclaim, pg 6, ln 12 – pg 14, ln 27. The Hotel has never argued that Kitross, or
5 anyone else for that matter, could not use the words “Beverly Hills.” Rather, the
6 Hotel has always argued that it is Kitross's use of those words ***in the Hotel's***
7 ***protected logo*** which has been the issue. Kitross misunderstands and misrepresents
8 the issues of this case and as a result, the court should strike this material under Rule
9 12(f).

10 2. Brunei Statements

11 Additionally, Kitross's statements regarding the Dorchester Collection Brunei
12 owner should be stricken from the record as gratuitous, salacious, and immaterial.
13 *See* Defendant's Answer and Counterclaim at pg 18, ln 22 – pg 19, ln 15. These
14 statements have absolutely no shred of relevance for the Hotel's claims nor Kitross's
15 defenses, and are plainly inserted to inflame emotions and prejudice the Hotel. The
16 cited material is plainly irrelevant to these claims and the should be stricken under
17 FRCP 12(f).

18 IV. CONCLUSION

19 Kitross is plainly infringing the protected mark of The Beverly Hills Hotel,
20 and all issues relating to that infringement will be decided by virtue of the Hotel's
21 original complaint herein. The counterclaim offers nothing additional under its
22 claims for judicial declaration, does not and cannot state a claim for interference with
23 prospective economic relations, and includes factual allegations that are plainly
24 irrelevant. For these reasons, the Kitross counterclaim should be stricken in its
25 entirety.

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1 DATED: February 12, 2024
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